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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/679,039	10/04/2000	Paul E. Jacobs	PA000373	5558

23696 7590 07/14/2003

Qualcomm Incorporated  
Patents Department  
5775 Morehouse Drive  
San Diego, CA 92121-1714

EXAMINER

ALVAREZ, RAQUEL

ART UNIT

PAPER NUMBER

3622

DATE MAILED: 07/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/679,039

Applicant(s)

JACOBS ET AL.

Examiner

Raquel Alvarez

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 04 October 2000.
- 2a) ☐ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-146 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-146 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All   b) ☐ Some \*   c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)                      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)                      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_                      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-40, 111-113, 126-127, 136-137 and 146 are drawn to transmitting ad statistical data, classified in class 705, subclass 10.

II. Claims 41-84, 114-119, 128-131, 138-141 are drawn to authorizing the use of a selection, classified in class 705, subclass 59 .

III. Claims 85-98, 120-122, 132-133, 142-143, are drawn to software usage protection , classified in class 705, subclass 51.

IV. Claims 99-110, 123-125, 134-135 and 144-145, are drawn to downloading of the the advertisements, classified in class 705, subclass 14.

2. Inventions of group I and groups II, III, IV, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group I has separate utility such as generating and transmitting statistical data. This separate use patentably distinguishes the invention of group I from groups II, III, IV, since the feature of generating and transmitting statistical data is not a limitation of those other independently claimed inventions. The generating and transmitting the statistical data of the invention of group I is separately usable from the inventions of groups II, III, IV,. Therefore the invention of group I is a separately usable subcombination. See MPEP § 806.05(d).

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3. Inventions of group II and groups I, III, IV, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group II has separate utility such as authorizing the use of a particular selection. This separate use patentably distinguishes the invention of group II from groups I, III, IV, since the feature of authorizing the use of a selection is not a limitation of those other independently claimed inventions. The authorizing the use of a selection shows that the invention of group II is separately usable from the inventions of groups I, III, IV. Therefore the invention of group II is a separately usable subcombination. See MPEP § 806.05(d).

4. Inventions of group III and groups I, II, IV, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention of group III has separate utility such as software usage protection. This separate use patentably distinguishes the invention of group III from groups I, II, IV, since the feature of software usage protection is not a limitation of those other independently claimed inventions. The software usage protection shows that the invention of group III is separately usable from the inventions of groups I, II, IV. Therefore the invention of group III is a separately usable subcombination. See MPEP § 806.05(d).

5. Inventions of group IV and groups I, II, III, are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, invention

of group IV has separate utility such as downloading of the advertisements. This separate use patentably distinguishes the invention of group IV from groups I, II, III, since the feature of downloading the ads is not a limitation of those other independently claimed inventions. The downloading of the ads shows that the invention of group IV is separately usable from the inventions of groups I, II, III, Therefore the invention of group IV is a separately usable subcombination. See MPEP § 806.05(d).

6. The inventions are distinct, each from the other because of the following reasons: the reasons given above and have acquired a separate status in the art as shown by different classification and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purpose as indicated is proper.

7. Since the restriction is complex and examiner knows from past experience that an election will not be made by telephone, this restriction is proper under MPEP 812.01.

### **Conclusion**

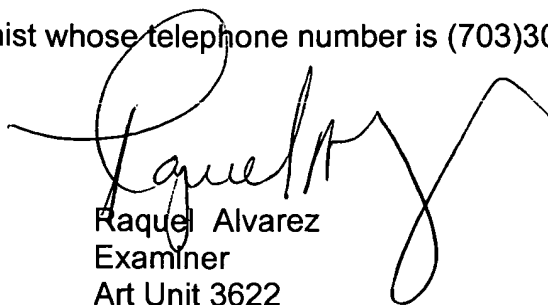
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Raquel Alvarez whose telephone number is (703)305-0456. The examiner can normally be reached on 9:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric w Stamber can be reached on (703)305-8469. The fax phone numbers

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for the organization where this application or proceeding is assigned are (703)872-9326 for regular communications and (703)872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1113.



Raquel Alvarez  
Examiner  
Art Unit 3622

R.A.  
July 11, 2003